

**REMARKS**

Reconsideration and allowance of the subject application are respectfully requested. Claims 3, 5, 28, 29, and 49-64 are now pending. Applicants have canceled claims 1, 2, 4, 6-27, and 30-48 without prejudice or disclaimer and have added new claims 61-64. Claims 3, 5, 28, 29, 49, and 55 have been amended.

**Prior Art Rejection**

Claims 1-60 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Enomoto et al.* (U.S. Patent 5,974,401) in view of *Mayle et al.* (U.S. Patent 6,018,774). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Initially, Applicants note that independent claims 1 and 27 have been canceled in favor of newly-added independent claims 61 and 63. Independent claims 49 and 55 remain pending. Therefore, the following comments primarily address patentability issues in the context of independent claims 49, 55, 61, and 63.

**Independent Claim 61**

Independent claim 61 is directed to a network photograph service system. The system of claim 61 comprises: a plurality of photo-finishing laboratories, each including a laboratory server which stores picture images as image data; and a single center server installed in a service center, which receives a printing service order via a network. The center server stores picture

images recorded by a customer as digital image data, makes the digital image data accessible on the network, selects one photo-finishing laboratory out of said plurality of photo-finishing laboratories to output a print in response to order information transferred from the customer via the network, and provides the printing service requested in the order by transmitting instruction information to the laboratory server installed in the selected photo-finishing laboratory, thereby enabling the customer to select a desired photo-finishing laboratory out of a plurality of photo-finishing laboratories to perform the printing service. The center server stores templates as image data, makes the templates accessible on the network, and transmits information regarding at least one template specified by the order information, as a portion of the instruction information when a manipulated printing service using the template is requested by the order information. The center server stores the image data in correlation with storage location information showing the laboratory server in which the image data is stored, and selects, upon selection of the photo-finishing laboratory to output the print, the photo-finishing laboratory in which the laboratory server stores the picture image whose print has been ordered, based on the storage location information. The photo-finishing laboratory selected to output the print carries out processing the picture image to be printed by synthesizing the picture image and the template specified by the

order information, and carries out printing of the manipulated image.

The primary reference, *Enomoto*, discloses a digital print order and delivery method and system in which a user 10 sends image data and print order data to a selected photofinisher 12. Fig. 1; col. 7, lines 14-22. In this system, the user's personal computer 11 accesses a photofinisher list 25, which allows the selection of a preferred photofinisher 12. Col. 8, lines 34-41.

*Enomoto* fails to teach or suggest a network photograph service system as defined in claim 61, which comprises a plurality of photo-finishing laboratories that each include a laboratory server and a center server, in which the center server stores template and picture image data, a laboratory server carries out processing of the picture image by synthesizing the picture image and the template for printing the processed image, and the processing and printing are carried out by a desired laboratory server selected in accordance with the customer's print service order.

Applicants respectfully submit that the Examiner's reliance on *Mayle* fails to make up for these deficiencies.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied reference or in knowledge generally available to one skilled in the art. *In re*

*Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Thus, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-09, 200 USPQ 504, 510 (CCPA 1979).

Applicants respectfully submit that the asserted combination of *Enomoto* and *Mayle* (assuming these references may be combined, which Applicants do not admit) fails to establish *prima facie* obviousness of independent claim 61 or any claim depending therefrom.

### **Independent Claim 63**

Independent claim 63 is directed to a network photograph service system. The system of claim 63 comprises: a plurality of photo-finishing laboratories, each including a laboratory server; and a single center server installed in a service center, which receives a printing service order via a network. The center server selects one photo-finishing laboratory out of the plurality of

photo-finishing laboratories to output a print in response to order information transferred from a customer via the network, and provides the printing service requested in the order by transmitting instruction information to the laboratory server installed in the selected photo-finishing laboratory, thereby enabling the customer to select a desired photo-finishing laboratory out of a plurality of photo-finishing laboratories to perform the printing service. The center server maintains a record of processing instructed for each laboratory server by transmitting the instruction information, and manages a transaction occurring between the photo-finishing laboratories and/or between the center server and each photo-finishing laboratory, based on the record.

Therefore, according to claim 63, the center server installed in a service center receives a printing service order via a network and transmits instruction information based on the received printing service order to a laboratory server of a selected photo-finishing laboratory and maintains a record of the processing instructed in accordance with the instruction information so as to manage transactions.

Applicants respectfully submit that the asserted combination of *Enomoto* and *Mayle* fails to teach or suggest at least this aspect of the system defined by claim 63. Accordingly, the asserted grounds of rejection fails to establish *prima facie* obviousness of claim 63 or any claim depending therefrom.

**Independent Claims 49 and 55**

Independent claim 49 is directed to a network photograph service method. The method of claim 49 comprises: providing a plurality of photo-finishing laboratories, each including a laboratory server in which picture images have been stored, and a single center server installed in a service center in which picture images as image data whose resolution is lower than the resolution of the picture images stored in the laboratories have been stored; making the digital image data stored in the center server accessible on the network; selecting one photo-finishing laboratory out of the plurality of photo-finishing laboratories to output a print in response to order information transferred from a customer via the network; and providing the printing service requested in the order by transmitting instruction information to the laboratory server installed in the selected photo-finishing laboratory, thereby enabling the customer to select a desired photo-finishing laboratory out of a plurality of photo-finishing laboratories to perform the printing service. The center server stores the digital image data in correlation with storage location information showing the laboratory server in which the image data is stored as high resolution image data, and selects, upon selection of the photo-finishing laboratory to output the print, the photo-finishing laboratory in which the laboratory server stores the high

resolution image data of the picture image whose print has been ordered, based on the storage location information.

As described above, *Enomoto* discloses a digital print order and delivery method and system in which the user 10 selects a desired photofinisher 12 in accordance with a photofinisher list 25 accessed by the user's personal computer 11. *Enomoto* fails to teach or suggest the network photograph service method defined by claim 49, in which the center server stores low resolution picture images corresponding to high resolution image data stored at the individual photo-finishing laboratories and transmits instruction information to the laboratory server of a selected photo-finishing laboratory, in accordance with the photo-finishing laboratory that stores the high resolution image data for the selected print information.

The Examiner's reliance on *Mayle* fails to make up for this deficiency of *Enomoto*. Accordingly, Applicants respectfully submit that the asserted combination of *Enomoto* and *Mayle* (assuming these references may be combined, which Applicants do not admit) fails to establish *prima facie* obviousness of claim 49, or any claim depending therefrom. Applicants respectfully submit that this same reasoning applies to independent claim 55, and claims depending therefrom.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

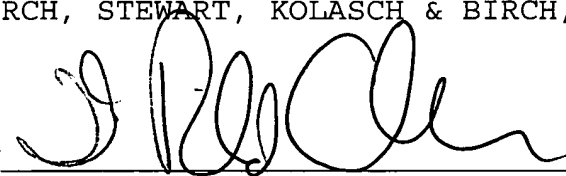
Applicants respectfully petition for a three (3) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$1,020.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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